

REMARKS/ARGUMENTS

Applicant respectfully requests that the examiner notice the “Change of Correspondence Address, Power of Attorney, and Revocation Of Previous Powers” filed on April 5, 2005. Applicant respectfully requests that the examiner notice that “Attorney Docket No.” of the present application is changed from “EDC-001” to “05306.P132” since the filing of the “change of correspondence address, power of attorney, and revocation of previous powers”.

The amended listing of claims and the following arguments are presented to impart precision to the claims, by particularly pointing out and distinctly claiming the subject matter. The pending claims are supported by the specification. No new matter is added.

Applicant respectfully submits that the currently pending claims are patentable over the cited references.

Applicant thanks the examiner for the serious effort to search and retrieve, since the examination relied heavily upon non patent literature.

35 U.S.C. §102(a) Rejections

Claims 1-2 were rejected under 35 U.S.C. §102(a) as being anticipated by Gillespie, “Market Overview: Electronic Presentation and Payment” (hereinafter “Gillespie”). Claims 1-11 were rejected under 35 U.S.C. §102(a) as being anticipated by Gillespie, or under 35 U.S.C. 103(a) as obvious over Gillespie. Applicant respectfully disagrees.

Applicant respectfully submits that the rejection of claims 1-11 under 35 U.S.C. §102(a) is improper and the rejection of claims 1-11 under 35 U.S.C. 103(a) is also improper. In this section, the rejection under 35 U.S.C. §102(a) is discussed; and the rejection under 35 U.S.C. 103(a) is discussed in the next section under the heading “35 U.S.C. §103(a) Rejections”.

The Office Action admitted that Gillespie is dated November 28, 2001 and therefore most of the description of Gillespie is not prior art. The portion the Office Action relied upon is on page 11 of Gillespie, which listed a number of major providers of EPP products. The list shows EPP start dates of major vendors, such as ALLTEL, Avolent, BCE Emergis, etc. For example, ALLTEL has an EPP start date of 1998; Avolent has an EPP start date of 1995; and BCE Emergis has an EPP start date of 1997. On page 11, EPP is defined as “electronic presentment and payment: encompasses both bills and invoices”; EBPP is defined as “electronic bill presentment and payment: Distinguishes bills (from invoices or EIPP) to denote consumer recipient (vs. corporate recipient)”; and EIPP is defined as “electronic invoice presentment and payment: Distinguishes invoices (from bills, EBPP) to denote corporate or business recipients (vs. consumer recipient)”.

However, Gillespie (e.g., page 11) does not show any specific details of EBPP that were in practice before the effective filing date of the present application. Thus, at most Gillespie (e.g., page 11) indicates the existence of the field of EPP (electronic presentment and payment), which may include the fields of EBPP (electronic bill presentment and payment) and EIPP (electronic invoice presentment and payment), before the effective filing date of the present application.

However, this was an *extremely immature* market even as of the date of Gillespie (December 28, 2001, more than one year after the filing of the present application) (see, e.g., page 1, fourth lines under the heading “Giga Position”, Gillespie). Thus, the existence of the field is clearly not sufficient to assert that all aspects of the field were known at an EPP start date of a vendor.

Applicant respectfully submits that the portion of Gillespie that was relied upon for the rejection under 35 U.S.C. 102(a) does not show each and every aspect of the pending claims.

For example, claim 1 recites:

1. (Currently Amended) A computerized method of providing billing information, comprising:
receiving, over a communications network, a request for summary billing information, the request being automatically generated by a billing portal in response to an action by a billable entity associated with the billing portal;
requesting, over the communications network and in response to said receiving the request for the summary billing information, the summary billing information from a supplier of the summary billing information;
receiving, over the communications network, the summary billing information from the supplier of the summary billing information; and
transmitting, over the communications network to the billing portal, the summary billing information and detailed billing contact information, the detailed billing contact information to be usable by the billable entity to access detailed billing information from a supplier of the detailed billing information.

Applicant respectfully submits that the prior existence of EBPP and EIPP as indicated by Gillespie is not sufficient to anticipate the limitations recited in claim 1. The existence of EBPP and EIPP reads at most on the preamble of claim 1, no further. None of the limitations recited after the preamble is anticipated by the existence of EBPP and EIPP as indicated by Gillespie.

Further, the existence of EBPP and EIPP as indicated by Gillespie does not anticipate the additional limitations recited in the dependent claims 2-11.

Thus, the withdrawal of the rejection under 35 U.S.C. 102(a) for claims 1-11 is respectfully requested.

35 U.S.C. §103(a) Rejections

The Office Action rejected claims 1-11 under 35 U.S.C. 103(a) as obvious over Gillespie. The applicable portion of Gillespie is only about ten words: “electronic bill presentment and payment” and “electronic invoice presentment and payment”, which is not sufficient to anticipate each and every limitation recited in claim 1.

For example, the words “electronic bill presentment and payment” and “electronic invoice presentment and payment” do not provide sufficient evidence to determine whether or not the practice before the filing of the present invention includes: “receiving, over a communications network, a request for summary billing information, *the request being automatically generated by a billing portal in response to an action by a billable entity associated with the billing portal*”.

Further, in the applicable portion of Gillespie, there is no evidence indicating that the practice before the filing of the present invention includes: “*requesting, over the communications network and in response to said receiving the request for the summary billing information, the summary billing information from a supplier of the summary billing information*”.

Further, in the applicable portion of Gillespie, there is no evidence indicating that the practice before the filing of the present invention includes: “receiving, over the communications network, the summary billing information from the supplier of the summary billing information”.

Further, in the applicable portion of Gillespie, there is no evidence indicating that the practice before the filing of the present invention includes: “transmitting, over the

communications network to the billing portal, the summary billing information *and detailed billing contact information*, the detailed billing contact information to be usable by the billable entity to access detailed billing information from a supplier of the detailed billing information”.

Further, the Office Action admitted that the reference does not teach the limitations recited in the dependent claims.

Further, for example, claim 11 recites “translating the summary billing information from the first one of a plurality of different data formats into a predetermined data format” which was not mentioned at all in the Office Action.

The examiner bears the initial burden of *factually supporting* any *prima facie* conclusion of obviousness under 35 U.S.C. 103. A *prima facie* case of obviousness is established by presenting *evidence* that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

MPEP (2142, 2143) shows that “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.”

A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not “evidence”.

Since the Office Action failed to provide *factually supporting* for a rejection under 35 U.S.C. 103, the rejection under 35 U.S.C. 103 is improper.

Note that the applicable portion of Gillespie only indicates the existence of EBPP and EIPP in some forms before the filing of the present application. Applicant respectfully submits that such broad and vague indication is not sufficient to reject specify claims in these fields.

Furthermore, the Office Action mailed December 31, 2002 effectively outlined a number of patentable distinctions in the field by imposing the restriction requirement. The Office Action mailed on December 17, 2004 further confirmed that the restriction requirement is proper and made the restriction requirement final.

35 U.S.C. 121 provides:

“If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. ...”

MPEP 802.1 provides:

“The term “distinct” means that two or more subjects as disclosed are related ... AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)”

In the restriction requirement, the Office Action mailed December 31, 2002 clearly stated that invention I, II and III are *distinct* from each other. The Office Action mailed December 31, 2002 further stated the reasons that make invention I, II and III patentable over each other (distinct).

For example, the difference between “providing billing information at the request of the billable entity” and “providing billing information at the request of a billing consolidator” is sufficient to make inventions I and II patentable over each other.

For example, the difference between “providing billing information at the request of the billable entity” and “providing billing information using a dedicated software program” is sufficient to make inventions I and III patentable over each other.

For example, the difference between “providing billing information at the request of a billing consolidator” and “providing billing information using a dedicated software program” is sufficient to make inventions II and III patentable over each other.

The applicable portion of Gillespie does not show whether the billing information is provided at the request of a billable entity, a billing consolidator, or other entity. The applicable portion of Gillespie does not show whether the billing information is provided using a dedicated software program or others. In fact, the applicable portion of Gillespie provides no detailed information about the prior practice of EBPP and EIPP. Thus, based on the reasons the Office Action set for the restriction requirement, which was further considered proper in the Office Action of December 17, 2004, Applicant respectfully submits that the pending claims are patentable over the cited reference.

CONCLUSION

Applicant thanks the examiner for the serious effort to search and retrieve, since the examination relied heavily upon non patent literature. However, after the serious effort of the examiner to search and retrieve, the best reference available appears not sufficient to support serious rejections. Thus, allowance of the application is respectfully requested.

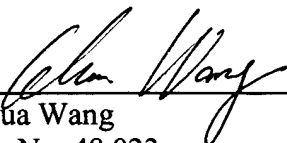
Applicant respectfully submits that the pending claims are patentable over the cited references. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if a further extension is required, Applicant hereby requests such extension.

Respectfully submitted,

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